

REMARKS

Claims 1, 14, 17, and 21 have been amended. No new matter has been introduced with these amendments, all of which are supported in the application as originally filed. Claims 7 - 12 were previously cancelled from the application without prejudice. Claims 1 - 6 and 13 - 26 remain in the application.

Applicants are not conceding that the subject matter encompassed by the claims as presented prior to this Amendment is not patentable over the art cited by the Examiner, as claim amendments and cancellations in the present application are directed toward facilitating expeditious prosecution of the application and allowance of the currently-presented claims at an early date. Applicants respectfully reserve the right to pursue claims, including the subject matter encompassed by the claims as presented prior to this Amendment and additional claims, in one or more continuing applications.

I. Objection to the Claims

Paragraph 3 of the Office Action dated February 4, 2011 (hereinafter, "the Office Action") states that Claim 14 is objected to because of informalities, and notes that the dependency is incorrect. This typographical error has been corrected herein, and the Examiner is therefore respectfully requested to withdraw the objection to the claims.

II. Rejection under 35 U. S. C. §101

Paragraph 5 of the Office Action states that Claims 1 - 6 and 13 - 16 are rejected under 35

U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. This rejection is respectfully traversed.

Claim 1 is an independent method claim, and Claims 2 - 6 and 13 - 16 depend therefrom. The Office Action indicates that a claim, in order to meet requirements of §101, must (1) be meaningfully tied to another statutory class, or (2) transform underlying subject matter. Applicants respectfully note that the “test” which is suggested by these statements in the Office Action is not the exclusive test for statutory subject matter in method claims. Furthermore, Applicants respectfully submit that the language of Claim 1 as currently presented is directed to statutory subject matter. Claim 1 recites “A computer-implemented method ...”, thus clearly indicating that the method cannot be performed solely by the human mind. In addition, Claim 1 recites transformative claim elements. For example, the claim language recited on lines 5 - 7 of Claim 1 states “... generating a content selection document ...”. Notably, this content selection document did not previously exist, and thus its generation comprises a transformation. As another example, line 11 of Claim 1 recites “... to create an updated version of the selected portion”. This is also a transformation, whereby the “selected portion” is transformed to “an updated version” thereof.

In view of the above, Applicants respectfully request that the Examiner withdraw the §101 rejection.

III. Rejection under 35 U.S.C. §103(a)

Paragraph 6 of the Office Action states that Claims 1 - 4, 13 - 23, and 25 - 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent 6,731,393 to Currans et al. (hereinafter, "Currans") in view of U. S. Patent Publication 2004/0019589 to Basrur. Paragraph 7 of the Office Action states that Claims 5 - 6 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Currans in view of Basrur and further in view of U. S. Patent Publication 2001/0043364 to Messner et al. (hereinafter, "Messner"). These rejections are respectfully traversed.

Referring first to independent Claim 1, the Office Action cites col. 15, lines 40 - 47 of Currans as teaching the claim language "responsive to selection, by a user from a view of content displayed on a graphical user interface from a source address, of a portion of the displayed content" which is recited on lines 3 - 4 of Claim 1. Applicants have amended this claim language herein to clarify that the selected portion comprises a subset of the displayed content.

With reference to the "registering a subscription ..." claim language recited on lines 8 - 9 of Claim 1, the Office Action cites **Fig. 15** of Currans, stating "user registration and user subscription interests". However, while **Fig. 15** depicts a column **612** titled "Subscription_info", Applicants find no teaching or suggestion in Currans of registering a subscription to a selected portion that comprises a subset of displayed content (referring to the antecedent as currently recited on line 4 of Claim 1).

For the "subsequently evaluating ..." claim element recited on lines 10 - 11 of Claim 1, the

Office Action cites **Figs. 2, 5, 7, and 8** of Currans, referring to “customized newspaper” and “documents can be requested from other sources”. However, Applicants respectfully note that this claim element recites “subsequently evaluating an updated version of the content ... using the generated content selection document ...” (emphasis added). That is, the content selection document which is generated according to the claim language recited on lines 6 - 8 of Claim 1 (“... generating a content selection document that specifies how to create the selected portion from the parsed markup language document”) is used in the “subsequently evaluating ...” claim element recited on lines 10 - 11. Applicants respectfully submit that Currans has no teaching or suggestion of using such content selection document when subsequently evaluating an updated version of content.

In fact, the Office Action admits that Currans does not disclose “parsing a markup language document from which the view was created and generating a content selection document that specifies how to create the selected portion from the parsed markup language document” (Office Action, page 5, lines 1 - 4), which is claim language recited on lines 5 - 7 of Claim 1. Because the Office Action admits that Currans does not disclose generating the content selection document as recited on lines 5 - 7 of Claim 1, it necessarily follows that Currans does not disclose using the generated content selection document as recited on lines 10 - 11 of Claim 1.

After admitting that Currans does not disclose the “parsing ... and generating ...” claim language recited on lines 5 - 7 of Claim 1, the Office Action then cites Basrur, referring to para. [0019] of Basrur and discussions therein of a parser **112**, etc. Applicants respectfully disagree

with this analysis. Notably, Applicants' claim language recites "... parsing a markup language document from which the view [of content] was created ..." (Claim 1, line 5, emphasis added). Applicants respectfully submit that Basrur has no teaching or suggestion of a markup language document from which a view of content was created, and it necessarily follows that Basrur has no teaching or suggestion of parsing such document.

Applicants' claim language also recites "... generating a content selection document that specifies how to create the selected portion [of the displayed content] from the parsed markup language document" (Claim 1, lines 5 - 7, emphasis added). While Basrur notes that a markup language document may be modified or created, Applicants find no teaching or suggestion in Basrur of generating a content selection document that can be aligned to Applicants' claim language when considering all the words recited therein as required by MPEP §2143.03. This section of the MPEP is titled "All Claim Limitations Must Be Considered" and is found within MPEP §2143 (titled "Examples of Basic Requirements of a *Prima Facie* Case of Obviousness"), and quotes *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970), which held that "All words in a claim must be considered in judging the patentability of that claim against the prior art." (emphasis added).

Because Basrur does not teach or suggest the "parsing ... and generating ..." claim language as demonstrated above, and because the Office Action admits that this claim language is not taught by Currans, Applicants respectfully submit that the cited references – whether taken singly or in combination (assuming, *arguendo*, that such combination could be made and that one

of ordinary skill in the art was motivated to attempt it) – do not render Claim 1 unpatentable.

Independent Claims 17 and 21 recite claim language analogous to independent Claim 1, and are rejected in the Office Action using the same analysis which is used for rejecting Claim 1. Accordingly, Claims 17 and 21 are deemed patentable over the references by virtue of the same arguments presented above with regard to Claim 1.

Dependent Claims 2 - 6, 13 - 16, 18 - 20, and 22 - 26 are deemed patentable at least by virtue of the patentability of the independent claims from which they depend.

In view of the above, the Examiner is respectfully requested to withdraw the §103 rejections of all claims as currently presented.

IV. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding rejections, and allowance of all currently-presented claims at an early date.

Respectfully submitted,

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